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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 822,623	03 30 2001	James M. Maloney	8195.28US01	7122

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 11 29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/822,623

Applicant(s)

MALONEY, JAMES M.

Examiner

Victor S Chang

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,3-13,15 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13,15 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

### *Response to Amendment*

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-13, 15 and 21-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The alleged improvements to prevent the label edge being inadvertently lifted or separated from the substrate has been argued as critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

More particularly, the limitations relating to the reduced amount of adhesive in the perimeter field which facilitate the label being retained in place and not being inadvertently lifted or separated from the substrate (e.g., Specification, page 10, lines 25-29) are not incorporated in the independent claims. Further, with respect to

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Applicant's argument that Voy teaches away from a modification having a reduced adhesive at its periphery (Response, page 7, last two paragraphs), it is noted that the independent claims are entirely devoid of the aforementioned alleged solved problems. The Examiner strongly suggests that all the independent claims be so amended, e.g., in their preambles, to contain a suitable recitation of the aforementioned problems the invention is directed at solving.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner would like to strongly suggest rewrite the newly added claim 23 so as to essentially mirror claim 1. For example:

In claim 23, line 2, change "defining a having" to --having a--, and after "side" insert --and defining an outer perimeter edge--.

The Examiner also would like to suggest revising claims 25-28, and incorporating certain of their elements into claim 23, following the guidelines set forth above.

7. Claims 1, 3-13, 15 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voy et al. (US 5351426) in view of Steidinger (US 5700536).

Voy's invention is related to labels with various shapes and discrete zones of adhesives as desired (Figs. 5 and 9-11). A transverse leading edge of each label is adhesive-free, which improves releasability of the labels from the carrier sheet during

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label application (Abstract). The zones are recessed from the peripheries of the labels.

If desired, the adhesive can be applied in zones with peripheries precisely corresponding to the peripheries of the labels (column 19, lines 5-7). Voy also teaches that the label is buried beneath a transparent film through which the print can be read (column 4, lines 14-15) and the labels are contained within a single, continuous, non-perforated sheet capable of being wound into a roll (column 4, lines 51-53). Further, Voy teaches that a rotary screen printing head is used to apply the adhesive (column 7, lines 2-3). Voy lacks the specific teaching of improving the releasability of the labels from the carrier sheet by applying reduced amount of adhesive at the peripheries. However, Steidinger's invention, directed to an integrated label product, teaches that the loose unglued margins causes folding over or getting caught in the process of feeding the forms both during manufacture and also in subsequent use (column 1, lines 39-43), and the problem can be solved by applying secondary adhesive in the previously adhesive free margin (column 2, lines 54-55). The secondary adhesive is used only to hold down the marginal edges to prevent them from folding over, lifting, etc. (column 2, lines 65-67). In Fig. 6, Steidinger shows that the secondary adhesive is applied as dots or the like which have small volumes of glue (column 4, lines 2-6). Although Voy does not expressly teach the exact dimensions of the zones, it is believed that it is either inherently disclosed or an obvious optimization to one of ordinary skill in the art of adhesive label sheet. As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to improve Voy's label construction by applying a reduced amount of adhesive density at the peripheries, as

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taught by Steidinger, motivated by the desire to avoid the problems, such as folding over and lifting, and still retain the releasability of the label.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
November 20, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*